

## **REMARKS**

### **I.     Status of the Claims**

Claims 1-52 are pending in this application. Claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34, 35, and 49-51 stand rejected, while claims 26, 28, 29, 33, and 36-47 are canceled. In response to a restriction requirement dated July 20, 2007, Group I was elected and claims 3, 4, 7-12, 15, 16, 18-20 and 48 were thereby withdrawn. Applicants reserve the right to pursue this subject matter in an application claiming priority to the present application.

Claim 1 has been amended to correct obvious typographical errors in species for R<sub>2</sub>. Claim 1 has also been amended to delete the first, second, third, fourth, and sixth species from the genus of variable R<sub>2</sub> in the compound of formula I. New claim 52 recites these five species such that no new matter has been added. As claim 52 is drawn to non-elected subject matter, this claim has been introduced as a withdrawn claim.

Amendment of the originally filed claims, or cancellation of any claims should in no way be construed as an acquiescence, narrowing, or surrender of any subject matter. The amendments are being made not only to point out with particularity and to claim the present invention, but also to expedite prosecution of the present application. Applicants reserve the option to prosecute the originally filed claims further, or similar ones, in the instant or subsequently filed patent applications.

### **II.    Priority Claim**

The Examiner has recognized Applicants' claim for the benefit of priority to U.S. Serial No. 60/465,583, filed April 25, 2003. *Office Action* at p. 2. However, the Examiner contends that a priority claim to U.S. Serial No. 60/431,406, filed December 6, 2002, cannot be recognized as the '406 application allegedly does not comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. *Id.* According to the Examiner, the '406 application does not support the elected Group I claims because variable R<sub>3</sub> on Formula I cannot be a pyrido[2,3-e]-1,4-diazepine ring. *Id.*

Applicants acknowledge that the elected subject matter is entitled to a priority date of April 25, 2003. Claim 1 has been amended to recite elected subject matter that is fully supported by the disclosure of the '583 application, filed April 25, 2003.

Applicants further submit that the '406 application, filed December 6, 2002, enables the scope of claim 1 wherein L is alkenyl and R<sub>2</sub> is selected from the first, second, third, fourth and sixth listed species. For clarity, this subject matter has been deleted from claim 1 and recited in new claim 52. Applicants assert that new claim 52 is entitled to a priority date of December 6, 2002.

### III. Rejection under 35 U.S.C. § 102

Claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34, 35, and 49-51 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2006/0142265 ("Berman"). *Id.* at p. 3. The disclosure in Berman relied upon by the Examiner as the basis for the 102(e) rejection must satisfy the requirements of 35 U.S.C. § 112, first paragraph. M.P.E.P. § 706.02(f)(1). Berman's earliest effective filing date is March 17, 2003, based on U.S. Serial No. 60/455,189. Berman also claims priority to two provisional applications with filing dates after April 25, 2003, and these documents can not form the basis of a §102(e) rejection based on that date.

For Berman to be effective prior art against the rejected claims, the disclosure relied upon in Berman must find the requisite support in the first Berman priority document (the '189 application).

The '189 application does not disclose any compound falling within the scope of amended claim 1. Rather, the '189 application discloses a compound of formula I wherein variable R<sub>3</sub> (analogous to R<sub>2</sub> in the present application) may be selected from 12 species. However, none of these species correspond to the R<sub>2</sub> species of amended claim 1. Thus, support for Berman's alleged disclosure of anticipatory subject matter does not exist as of the March 17, 2003, filing date of the '189 application. Therefore, Berman does not anticipate the present claims.

#### IV. Conclusion

Applicants respectfully request that this Response under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34, 35, and 49-51 in condition for allowance. Applicants submit that the proposed amendment of claim 1 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Response should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Response would allow Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the Response would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art cited against this application. Applicants therefore request the entry of this Response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Any questions raised by this submission may be directed to the undersigned at (617) 570-3914. In accordance with 37 C.F.R. § 1.136(a), please grant any extension of time that this paper requires but no accompanying paper requests. The Commissioner is hereby authorized to charge any underpayments, or credit any overpayments, to our Deposit Account No. 07-1700,

**Reference: IPT-075.**

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Respectfully submitted,

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